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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/505,632	02/16/00	SCROGGIE	M 7791-0103-25

LMC1/1003  
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EXAMINER

ROBINSON BOYCE, A

ART UNIT	PAPER NUMBER
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2765

DATE MAILED:

10/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/505,632

Applicant(s)  
Scroggie, et al

Examiner  
Akiba Robinson-Boyce

Group Art Unit  
2765



☒ Responsive to communication(s) filed on Sep 11, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 24-49 is/are pending in the application.

Of the above, claim(s) 32, 33, 35, 44, 45, and 47 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 24-31, 34, 36-43, 46, 48, and 49 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of claims 24-31, 34, 36-43, 46, 48, and 49 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that since MPEP 803 recites "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.", the applicant believes that the restricted claims appear to be part of an overlapping search area since they are in class 705 and the burden on the examiner would be minimal. This is not found persuasive because the restricted claims disclose completely different subject matters which would result in an extensive search beyond the class 705 area. For example, claim 24 discloses: "transmitting from a client computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives...transmitting region data for said Web site of said manufacturer over the Internet to a remote Web site...transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address...transmitting

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from said Web site of said manufacturer over the Internet to said client computer said at least one manufacturer incentive said at least one name and address...” while claim 32 recites: “transmitting shelf tag data used to generate printed price shelf tags and cross-reference data for current retailer specials...reformatting said shelf tag data and cross-reference data for input...updating said retailer specials database”. The subject matter of these claims are irrelevant. Transmitting a request for a manufacture incentive has nothing to do with transmitting shelf tag data. These subject matters would require two completely different searches. Even claim 35 would require a search in a different area because of the introduction of the advertisement banner.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 32-33, 35, 44, 45, and 47 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected claims, the requirement having been traversed in Paper No. 7.

### ***Claim Objections***

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3. Claims 25, 27 and 39 are objected to because of the following informalities:  
Spelling errors; In claim 25, "sites" should be replaced with "site" and in claims 27 and 39, "Web sire" should be replaced with "Web site". Appropriate correction is require

***Claim Rejections - 35 USC § 112***

4. Claim 25 is rejected under 35 USC 112 because it recites the limitation "said list". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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6. Claims 28, 34, 40, 46, are rejected under 35 U.S.C. 102(e) as being anticipated by Sloane (US Patent 5,918,211).

As per claim 28, 34, 40, 46, Sloane discloses:

transmitting from a client computer.../means for transmitting from a client computer...(Col. 7, lines 5-10);

in response to receipt of said request at said Web site of said retailer.../means for, in response to receipt of said request at said Web site of said retailer (Col. 7, lines 13-22);

in response to receipt of said request at said remote site.../means for, in response to receipt of said request at said remote site...(Col. 7, lines 22-26);

in response to receipt of said manufacturers incentives.../means for, in response to receipt of said manufacturers incentives...(Col. 8, lines 3-7).

updating a manufacturers incentives database.../means for updating...(col. 7, lines 36-40).

***Claim Rejections - 35 USC § 103***

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 24-27, 29-31, 36-39, 41-43, 48, 49 are rejected under 35

U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211) as applied to claim above, and further in view of Allsop, et al. (5,970,472).

As per claim 24, 36, 48, 49, Sloane discloses:

transmitting from a client computer over the Internet to a Web site of a manufacturer a request.../means for transmitting...in response to said request for manufacturer incentives, transmitting region data...means for, in response to said request...in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive.../means for, in response to receipt of region data...(Col. 7, lines 5-26);

Sloane fails to teach the following, however Allsop, et al discloses:

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transmitting...at least one name.../means for transmitting...at least one name...(Col. 5, lines 41-57);

It would have been obvious to one of ordinary skill in the art to transmit at least one name of the retailer and the manufacturer so the consumer will recognize which retailer and manufacturer should be used in order to get the desired incentives. This recognition would increase sales through those particular retailers and manufacturers.

As per claim 25, 37, Sloane fails to disclose the following, however Allsop, et al. discloses:

wherein said step of transmitting from said remote site said list further comprises transmitting a link.../wherein said means for transmitting from said remote site said list further comprises means for transmitting a link...(Col. 7, lines 24-35).

It would have been obvious to one of ordinary skill in the art to transmit a link to a Web site of at least one retailer so the request for products and incentives for a specific retailer can be sent to the correct location.



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As per claims 26, 30, 38, 42, Sloane fails to disclose the following, however Allsop, et al. discloses:

determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying.../means for determining...transmitting from the client computer over the Internet to the Web site of the retailer region data.../means for transmitting...(Col. 8, lines 32-49).

It would have been obvious to one of ordinary skill in the art to determine at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using region data, a database from a server of a remote Web site because by querying, all of the unwanted data can be filtered out of the search resulting in a quick, efficient way of obtaining desired incentive information.

As per claim 27, 39, Sloane discloses:

transmitting from said client computer.../means for transmitting...(Col. 10, 3-7, col. 11, lines 47-48, col. 12, lines 4-8);

Sloane fails to disclose the following, however Allsop, et al. discloses:

transmitting from said Web site of said manufacturer.../means for transmitting from said Web site...(Col. 10, lines 36-46);

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transmitting from said remote site to said Web site of said manufacturer details.../means for transmitting from said remote site...(Col. 11, lines 50-60);

transmitting from said Web site of said manufacturer to said client computer.../means for transmitting from said Web site of said manufacturer...(col. 11, line 50-col. 12, line 3).

It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Allsop, et al. into Sloane because all of these additional steps are necessary for ensuring that significant details of manufacturer selection data are sent to the correct location.

As per claims 29, 41, Sloane fails to disclose the following, however Allsop, et al. discloses:

transmitting a user identification.../means for transmitting a user identification...determining manufacturer's incentives.../means for determining manufacturer's incentives...(Col. 5, lines 41-63).

It would have been obvious to one of ordinary skill in the art to transmit a user identification from a Web site of the retailer to a remote web site and to determine the manufacturer's incentives to transmit from the remote Web site to a retailer Web

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site because the incentives are user specific. One needs to know the user identity in order to receive the correct incentive.

As per claim 31, 43, Sloane fails to teach the following, however Allsop, et al. discloses:

wherein said region data is postal code data...(Col. 8, lines 32-49).

It would have been obvious to one of ordinary skill in the art for the region data to be postal code data in order to determine if the retailer is in close proximity with the user resulting in a better match between the user and the retailer.

### ***Conclusion***

9. An inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba Robinson-Boyce whose telephone number is (703) 305-1340. The examiner can normally be reached on Monday-Friday from 6:30 AM-3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Swann, can be reached on (703) 308-7791. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3988.

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An inquiry of a general nature or relating to the status of this application proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

**Akiba Robinson-Boyce**

**Patent Examiner**

**Group Art Unit 2765**

**September 29, 2000**

A handwritten signature in black ink, appearing to read "Eric W. Stamber", with a stylized, flowing script.

ERIC W. STAMBER  
PRIMARY EXAMINER